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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,751	12/04/2003	Chris Gorman	SDS-8394	7607
23334 7590 02/23/2007 FLEIT, KAIN, GIBBONS, GUTMAN, BONGINI & BIANCO P.L. ONE BOCA COMMERCE CENTER 551 NORTHWEST 77TH STREET, SUITE 111 BOCA RATON, FL 33487			EXAMINER LAUX, JESSICA L	
			ART UNIT 3635	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/23/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/727,751	Applicant(s) GORMAN, CHRIS	
	Examiner Jessica Laux	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-24 is/are allowed.
- 6) ☐ Claim(s) 1-13, 15-20 is/are rejected.
- 7) ☐ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgment is made of the amendment filed 1/11/2007. Accordingly claims 1, 10, 18 have been amended.

Response to Arguments

Applicant's arguments filed 01/11/2007 have been fully considered but they are not persuasive.

Applicant argues that the arms of Hoh are not wave shaped because they do not have peaks and troughs. Examiner disagrees with this noting that the "striations" of the arms do have peaks and troughs and that they are wave shaped.

Applicant argues further that the grooves run long ways along the arms and would butt up against the edges of a gap with smaller dimensions than the distance between the peak and trough and that therefore the shim would never fit inside the gap to exert outward pressure. Examiner disagrees with this noting that the shim may be inserted into a smaller gap in various ways and from many sides and angles and that it would be possible for the shim to fit inside the gap to exert outward pressure. Examiner further notes that the arms of Hoh are compressible as any material is inherently compressible under the appropriate amount of applied pressure.

Applicant argues that Colt does not disclose a wave shaped arm. Examiner disagrees noting that applicant's own cited definition of wave shaped includes "to follow a curving line" which the arm of Colt does when following the line of the arm starting at element 10 and continuing to element 11 (as seen in figure 1). Examiner further notes

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that the arms of Colt are compressible as any material is inherently compressible under the appropriate amount of applied pressure.

For these reasons applicant's arguments are not convincing and an examination of the claims is presented below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6-7, 10-12, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoh et al. (4232068).

In regards to claim 1: Hoh et al. teaches a shim (1), comprising a body with a first portion (2) and a second portion (3); and a slot (Figure 2) dividing the first portion of said body into a pair of compressible wave-shaped extending arms (2 and 3) that are capable of being compressed when inserted into a gap defined by opposing surfaces and having a dimension smaller than a distance between a trough and a peak of the wave and thereby exerting outward pressure on the surfaces of the gap.

The amended limitation add to the claim is a recitation of an intended use, which does not further limit the structural features of the claimed invention. It has been held that a recitation regarding the manner in which a claimed apparatus is intended to be used does not differentiate the claimed apparatus from a prior art apparatus which

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satisfies the claimed limitations. Since the apparatus of Hoh is capable of the claimed intended use the claim limitations are anticipated by the prior art.

In regards to claim 2: The shim according to in claim 1 above, which further comprises a tab (5) attached to said body at a side opposite said wave-shaped extending arms.

In regards to claim 3: The shim according to claim 2 above, wherein said tab is attached to said body via an area of reduced body material (6) at a junction point between said tab and said body.

In regards to claim 6: The shim according to claim 1 above, wherein at least one area of reduced body material exists at corresponding locations along each of said wave-shaped extending arms (2a and 3a).

In regards to claim 7: The shim according to claim 1 above, wherein said body is comprised of a single piece of material (Figure 3).

In regards to claim 10: Hoh et al. teaches a shim assembly comprising a plurality of bodies (Figure 5), each with a first portion (2) and a second portion (3) and formed with a slot dividing the first portion into a pair of compressible wave-shaped extending arms that are capable of being compressed when inserted into a gap defined by opposing surfaces and having a dimension smaller than a distance between a trough and a peak of the wave and thereby exerting outward pressure on the surfaces of the gap, and each of said wave-shaped bodies are removably attached to at least one other one of said wave-shaped body (Figure 5 and Col. 4, line 3).

The amended limitation add to the claim is a recitation of an intended use, which does not further limit the structural features of the claimed invention. It has been held that a recitation regarding the manner in which a claimed apparatus is intended to be used does not differentiate the claimed apparatus from a prior art apparatus which satisfies the claimed limitations. Since the apparatus of Hoh is capable of the claimed intended use the claim limitations are anticipated by the prior art.

In regards to claim 11: The shim assembly according to claim 10 above, which further comprises a tab (5) attached to each of said bodies at a side opposite said wave-shaped extending arms (Figure 5).

In regards to claim 12: The shim assembly according to claim 11 above, wherein said tab is attached to said body via an area of reduced body material (6) on each said body at a junction point between each said tab and each said body.

In regards to claim 15: The shim assembly according to claim 10, wherein at least one area of reduced body material exists at corresponding locations along each of said wave-shaped extending arms (2a and 3a; Figure 5).

Claims 1-2 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Colt (1552912).

In regards to claims 1: Colt teaches a shim, comprising a wave-shaped body (as depicted in Figure 2) formed with a slot (8) dividing a portion of said body at an end thereof into a pair of compressible wave-shaped extending arms (12 and 13) that are capable of being compressed when inserted into a gap defined by opposing surfaces

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and having a dimension smaller than a distance between a trough and a peak of the wave and thereby exerting outward pressure on the surfaces of the gap.

In regards to claim 2: The shim according to in claim 1 above, which further comprises a tab (10) attached to said body at a side opposite said wave-shaped extending arms.

In regards to claim 9: The shim according to claim 1 above, wherein at least one of said extending arms has a first surface and a second surface opposite said first surface, and said extending arm (12 or 13) is formed with at least one through-hole (17) running from said first surface to said second surface.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoh et al. (4232068).

Claim 18 merely recites the obvious method of inserting the shim of claim 1 above. It would have been obvious to one of ordinary skill in the art at the time the invention was made to insert a shim into a gap as it is well known in the art to insert shims in a gap between two elements.

In regards to claim 19, Hoh et al. teaches the tab portion to be removable after proper location of the shim.

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Claim 20 merely recites the obvious method of removing the portions after insertion. Further, Hoh et al teaches that the leg portions may be broken off to adjust the length of the legs (abstract), but is silent in regards to when to break them off. It would be obvious to one of ordinary skill in the art at the time the invention was made to break off extra length after insertion to ensure the shim is of the correct length.

Claims 4, 8, 13, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoh et al (4232068) in view of Grove Products Inc.

In regards to claims 4 and 13: Hoh et al. teaches a shim as in claims 1-2 and 10-11 above having an area of reduced material at the tab for breaking off the tab after insertion, but does not teach the shim to have a groove being a complete void of material extending from the edge of the tab toward the center region of the tab. Grove Products Inc. teaches a shim having a tab with an edge and a perpendicular surface with a parallel surface wherein there is a groove, being a complete void of material extending from the edge in a direction towards a center of the tab, for ease in breaking off the tab after insertion. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the shim of Hoh et al. to have a groove as in the shim of Grove Products Inc. as such a modification would make for a more defined break-off point with less material attaching the two members together.

In regards to claims 8 and 16: Hoh et al. teaches a shim as in claims 1 and 10 above having an area of reduced material at the legs of the shim for breaking off the extra length of the leg after insertion, but does not teach the shim to have a groove being a complete void of material extending from the edge of the tab toward the center

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region of the leg. Grove Products Inc. teaches a shim having a leg with an edge and a perpendicular surface with a parallel surface wherein there is a groove, being a complete void of material extending from the edge in a direction towards a center of the leg, for ease in breaking off the extra length of the leg after insertion. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the shim of Hoh et al. to have a groove as in the shim of Grove Products Inc. as such a modification would make for a more defined break-off point with less material attaching the two members together.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Colt (1552912) in view of Hartin (DES 423909). Colt teaches a shim as in claim 1 above, where the shim has through-holes for securing the shim to an element, but does not teach the through-hole being located in the tab portion of the shim. Hartin teaches a shim having a tab with a through-hole. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the shim of Colt to have a through-hole located in the tab portion as such a modification would allow for easier access to the hole for securing the shim to an element.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoh (4232068) in view of Colt (1552912).

In regards to claim 17: Hoh discloses the shim as in claim 10 above, but does not expressly disclose at least one through-hole in the extending arms.

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Colt discloses a wave shaped shim with extending arms where each arm has a first surface (top) and a second surface (bottom) and at least one through-hole (17) running from said first surface to said second surface.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the shim of Hoh to have through-holes as disclosed by Colt as the through-holes allow for fasteners such as nails or screws for more securely positioning the shim in place.

Allowable Subject Matter

Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 21-24 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Laux whose telephone number is 571-272-8228. The examiner can normally be reached on Monday thru Friday, 6:30am to 2:30pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JL

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